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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,058	04/27/2001	Ian Cooper	D1815-00025 DIV1	3991
7590 03/15/2004 DUANE, MORRIS & HECKSCHER LLP One Liberty Place Philadelphia, PA 19103-7396			EXAMINER RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 03/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/844,058

Applicant(s)

COOPER ET AL.

Examiner

Ula C Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) 8, 9, 36, 37 and 40-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicant's amendment and accompanying remarks filed December 1, 2003. The 112, 1<sup>st</sup> paragraph rejections and the rejections in view of Newman et al. (US 6,054,205), Paulson et al. (US 6,171,984), Fangeat et al. (US 4,967,548), and Hourahane (US 6,335,087) have been overcome.

### ***Election/Restrictions***

2. Newly submitted claims 8, 9, 36, and 37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to a "reinforced cementitious board" which is the final product to the originally claimed "reinforcement for cementitious boards" which is the intermediate product. The original claims failed to positively require a cementitious board.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8, 9, 36, and 37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

It should be noted again that claims 40-46 are also drawn to a non-elected invention.

### ***Claim Objections***

3. Claim 8 is objected to because of the following informalities: the claim is dependent upon a non-elected claim. It is suggested that Applicant change the dependency to claim 1. Appropriate correction is required. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 3, 7, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Girgis et al. (US 4,762,750). Girgis et al. disclose flexible impregnated bundles impregnated with a chemical coating composition (abstract) that can be used as reinforcement mesh for concrete and gypsum (col 18, ln 16-19). The fiber bundles are made of glass fibers (col 4, ln 53-55) and can be formed into nonwoven scrims (col 1, ln 59-60 and col 18, ln 13-14). The glass fibers have a density of 3000-3250 denier or 333-361 tex (Table 4). The elastomeric polymers used in the coating are ethylene-containing interpolymers (col 6, ln 21-23) including ethylene propylene rubber (col 9, ln 41-44). The polymer coating can be applied via extrusion coating (col 17, ln 47-68 to col 18, ln 1-3). With regard to claims 2 and 3, because the impregnated fiber bundles are cured, a hardness of the coating results (col 10, ln 31-36). With regard to claim 7, the coated fabric has a thickness from less than 0.01 to greater than 0.06 inches (col 18, ln 35-36).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 6, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girgis et al. (US 4,762,750), as shown above. Girgis et al. disclose the claimed invention except for the teaching that the mesh has a strand count of about 2-18 strands/inch in each direction and that the glass fibers have a linear density of about 33 to about 300 tex. It should be noted that optimizing mesh strand count and linear density are result effective variables. For instance, the greater the mesh strand count directly affects the dimensional stability of the fabric. Furthermore, the larger the glass fiber density directly affects the strength of the fabric. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the mesh have a strand count of about 2-18 strands/inch in each direction and the glass fibers have a linear density of about 33 to about 300 tex, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized both the mesh strand count and linear density motivated by the desire to create a fabric having increased dimensional stability and strength.

With regard to claim 38, it should be noted that the method of forming an article is not germane to the issue of patentability of the article itself. Therefore, this limitation has not been given patentable weight. Furthermore, Girgis et al. disclose the extrusion of the coating and therefore, it is the Examiner's position that in the final product both the coating of Girgis et al. and the coating of the present invention will have the same properties.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-3, 5-7, 38, and 39 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR

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